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SERIAL NUMBER 09/1994, 537	FILING DATE 12/15/97	FIRST NAMED APPLICANT HORI	ATTORNEY DOCKET NO. K-0KTA-11
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QM31/0727

EXAMINER HIRSCH, F	
ART UNIT	PAPER NUMBER 3732

DATE MAILED:

07/27/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No. 08/994,537	Applicant(s) Hori et al
Examiner Paul Hirsch	Group Art Unit 3732



Responsive to communication(s) filed on Dec 19, 1997

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 27-29 is/are allowed.

Claim(s) 1-6, 8-12, 14-16, 18-20, and 30-32 is/are rejected.

Claim(s) 7, 13, 17, and 21-26 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). two

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

For the purpose of this action claims 16-33 have been renumbered 15-32 by the Examiner as no claim 15 was present.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-9, 14 and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Improper antecedent basis for “An endoscope”, line 1 of claims 8 and 14.

B. Claim 9, line 3, lacks proper antecedence for “said cable means”.

C. Claim 30, lines 8-11, “said device.....or a surgical grasper” are an improper Markush grouping of non-equivalent devices, and are thus indefinite in not being able to specifically determine what Applicant is claiming.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-2, 5-6, 20 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Thompson. Thompson teaches camera mounting means pivotally connected to an elongated support shaft with means to alter the azimuth (angle) of the camera as recite by the claims. In regard to claim 2 to the extent that the camera is mounted by support arms and/or a housing the camera is removable as recited by the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4, 9-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Lane. The use of conventional video display/processing systems such as

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taught by Lane within Thompson would be obvious within the art. Note conventional video processing teaching of Thompson. To the extent that claim 9 is reciting definite structure the actuating means of Thompson may be manually rotated if so desired. In regard to claim 10 specific mounting means of the camera is considered an obvious mechanical expedient/design. In regard to claim 11-12 note choice of material teaching of Thompson. In regard to claim 14 helical construction of endoscope shafts is considered conventional.

7. Claims 15-16, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson and Lane as applied to claims 3-4 above, and further in view of McCoy. Manual control of endoscope bendable shafts is considered well known within the art and would be obvious from McCoy if so desired.

8. Claims 7,13,17,21-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 27-29 are allowed.

10. Claims 8-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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11. C,E, F-M are cited as further teachings including camera-endoscope mount, flexibility and video controls.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Paul Hirsch whose telephone number is (703) 308-0858.



Paul J. Hirsch
Primary Examiner

pjh

July 16, 1998